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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,095	02/02/2004	Carole Jego Stora	59037US002	9275
32692	7590	08/24/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 08/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/770,095

Applicant(s)

STORA, CAROLE JEGO

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/2/06 Amendment.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-22 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4-22,24,25 and 27-33 is/are rejected.
- 7) ☒ Claim(s) 3, 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Applicants' amendment filed on June 2, 2006 is acknowledged.

Claims 1, 23 and 34 are deleted. Claims 2, 14, 24 and 33 are amended.

Now, Claims 2-22 and 24-33 are pending.

2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 020406) is/are removed.

3. Claim rejection(s) under 35 USC 103 in the previous Office Action (Paper No. 020406) is/are removed.

4. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

#### ***Claim Rejections - 35 USC § 112***

5. Claims 17 and 29 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 17 recites the limitation "the first portion and the second portion" in line 1. There is insufficient antecedent basis for this limitation in the claim. Should "claim 14" in line 1 be -- claim 15 --?

Claim 29 recites the limitation "The method" in line 1. There is insufficient antecedent basis for this limitation in the claim. Should "The method" in line 1 be -- sealable device --?

***Claim Rejections - 35 USC § 103***

6. Claims 14 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiotis (US 5 529 508) as evidenced by Dubrow and in view of De Ridder.

The following column and line numbers referring to De Ridder are based on its US equivalent (US 6 194 476).

Chiotis discloses a method of sealing a sealable device where the end of a hollow member is sealed using a sealing member comprising a layer of sealant between two constraining layers. (Figures 1-3, col. 2, line 27 to col. 3, line 20) The sealant material can be a polyorganosiloxane gel. Chiotis is silent on the use of a microsphere filler. However, Chiotis teaches that the sealant material can be the one taught in Dubrow. (col. 3, line 48 and col. 4, line 2) Thus, Dubrow teaches the use of a filler for decreasing the electrical

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conductivity, thermal conductivity and/or adjusting the density in a sealant comprising a polyorganosiloxane gel. (col. 2, lines 7-15 and col. 4, lines 58-68) As such, Chiotis as evidenced by Dubrow does disclose a sealant material comprising a filler for decreasing the **electrical** conductivity, **thermal** conductivity and/or adjusting the **density** thereof. Chiotis as evidenced by Dubrow is silent on the specific use of a microsphere filler. However, De Ridder teaches the use of a silicone gel containing a hollow compressible filler in a sealant material. The motivation of using the hollow compressible filler is to afford a sealant material with excellent **electrical** insulation, **thermal** insulation, etc. (col. 1, lines 60-65 and col. 5, line 66 to col. 6, line 6) Furthermore, the use of the hollow compressible filler can certainly lower the **density** of the sealant material. In light of the benefit mentioned, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to utilize De Ridder's hollow compressible filler.

7. Claims 2, 4-7, 14-16, 18-19, 24-25, 27-29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh (US 6 010 134) in view of Usami (US 5 099 088) and De Ridder (EP 971369).

The following column and line numbers referring to De Ridder are based on its US equivalent (US 6 194 476).

Katoh discloses a method of sealing an enclosable container (i.e., grommet for a wire **harness**). Note that the sealant material is present within less than the entire interior of container. (col. 2, line 29 to col. 5, line 24 and Figures) Katoh is silent on the specific use of a silicone gel as a sealant and a microsphere filler distributed therein set forth in the claimed invention.

Usami teaches a method of sealing a sealable device/enclosable container (i.e., a splicing apparatus such as a wire **harness**) utilizing a flexible sealant comprising a **silicone gel**. The motivation of using a silicone gel is provide an airtight sealing. (col. 4, lines 50-55) Especially, Usami is in the same field as that of Katoh's endeavor. De Ridder teaches the use of a silicone gel containing a hollow compressible filler for an electrically insulation seal.

The motivation of using this silicone gel is to effectively fill the hollow body that the **silicone gel** composition intended to fill in. (Abstract, col. 1, lines 3-7, col. 1, line 40 to col. 2, line 32, col. 2, line 54 to col. 5, line 8, col. 5, line 32 to col. 6, line 6 and Examples) Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made obvious to utilize a silicone gel and a hollow compressible filler as Katoh's sealant. De Ridder further teaches a **platinum** catalyst. (col. 4, lines 1-12

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and Examples) The details of the silicone gel/hollow compressible filler taught by Usami and De Ridder can be found in paragraph 7 of the previous Office action (Paper No. 091705). Usami further teaches that the silicone gel possesses a proper **tackiness** in order to provide the adequate adhesion between shell halves, etc. (col. 4, lines 23-26 and col. 8, lines 14-17) As such, the tackiness of the sealant is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to utilize a silicone gel sealant having whatever tackiness through routine experimentation in order to afford an desired adhesion between the shell halves of the enclosable container. Especially, Applicants do not show the criticality of the tackiness. See MPEP 2144.05 (II).

8. Claim 8-13, 20-22 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh in view of Usami and De Ridder as applied to Claims 2, 4-7, 14-16, 18-19, 24-25, 27-29 and 33 above, and further in view of Matsumoto (JP 63-28076).

Katoh in view of Usami and De Ridder is silent on the use of a silica. However, De Ridder teaches the use of a filler, etc. (col. 5, lines 4-8) Furthermore, Usami teaches that the silicone composition can be

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exemplified in Matsumoto (col. 3, lines 23-40). Matsumoto teaches the use of silica in the silicone composition. The motivation is to adjust the properties of the composition. (page 6, lower left column) Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate silica in the composition of Usami in view of De Ridder in an amount through routine experimentation in order to obtain a composition with desired properties. Especially, Applicants do not show the criticality of the silica amount. See MPEP 2144.05 (II).

9. Claims 3 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the above references, taken alone or in combination, teaches or fairly suggests the specific feature set forth in the instant claims.

10. Claim 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

None of the above references, taken alone or in combination, teaches or fairly suggests the specific feature set forth in the instant claims.



11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
August 17, 2006

  
Kuo-Liang Peng  
Primary Examiner  
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